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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86492323
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Applied for Mark	ZENEK
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of HUONG HAI SCIENCE AND TECHNOLOGY INC

Serial No. 86492323

Trademark: ZENEK

Filing Date: Dec. 30, 2014

**BRIEF OF THE APPLICANT**

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## **I. INTRODUCTION**

COMES NOW the Applicant HUONG HAI SCIENCE AND TECHNOLOGY INC (hereinafter “Applicant”) and through counsel The Trademark Company, PLLC, and provides this Brief of the Applicant in support of its appeal of the examining attorney’s refusal to register the instant mark.

## **II. STATEMENT OF THE CASE**

On or about Dec. 30, 2014 Applicant filed the instant trademark with the U.S. Patent and Trademark Office seeking to register the same on in connection with the following goods:

Cell phones; Computers; PC tablets; Wearable digital electronic devices comprised primarily of software and display screens for the use of smart phone capabilities and also featuring a wristwatch; Wireless indoor and outdoor speakers.

On or about April 8, 2015 the Examining Attorney refused registration of the Applicant’s trademark on the grounds that, if registered, it would create a likelihood of confusion with the registered trademark ZENEC more fully set forth in U.S. Registration No. 4503699. The registration is used on or in connection with the following goods:

Apparatus for recording, transmitting and reproducing sound or images; radios, amplifiers, equalizers, loudspeakers, television apparatus, touchscreen monitors, liquid crystal display monitors, video monitors, video cameras, CD and DVD playing apparatus, *all the aforesaid apparatus are also intended for mounting on vehicles*; parts for all the above products.

Of note, the registered mark contains a significant limitation in the identification of goods, namely “...*all the aforesaid apparatus are also intended for mounting on vehicles*...” See U.S. Registration No. 4503699.

On or about May 14, 2015 Applicant filed a response to the Office Action dated April 8, 2015 arguing in support of registration. However, ultimately Applicant’s argument was not

deemed persuasive by the Examining Attorney and, accordingly, on or about June 9, 2015 the Examining Attorney made the refusal final.

Following Applicant noting the instant appeal, Applicant moved to amend its identification of goods to limit the scope thereof apart from those of the registrant. Specifically, Applicant's goods now read as follows:

Cell phones; Computers; PC tablets; Wearable digital electronic devices comprised primarily of software and display screens for the use of smart phone capabilities and also featuring a wristwatch; Wireless indoor and outdoor speakers; *all of the foregoing not for mounting on vehicles.*

In this regard, Applicant sought to further distance its goods from those of the registrant by including "...*all of the foregoing not for mounting on vehicles...*" so as to clarify that the goods of the parties do not overlap and likely do not travel in the same channels of trade.<sup>1</sup>

However, the instant amendment was deemed insufficient by the Examining Attorney to remove the instant refusal and, accordingly, the instant appeal now timely follows.

### **III. ARGUMENT**

#### ***The Standard for a Determination of a Likelihood of Confusion***

A determination of likelihood of confusion between marks is made on a case- specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed . Cir. 1997). The Examining Attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;

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<sup>1</sup> Of note, although Applicant's amendment appears in TEAS the goods of the Applicant are still listed as the originally-filed for goods and not those with the limitation addressed herein. To the extent the goods have not been changed Applicant respectfully requests that the Board recognize that the goods are to be changed, as requested, and review the instant appeal in light of Applicant's amended identification of goods.

- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
- (5) The number and nature of similar marks in use on similar services; and
- (6) The absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

*Id.*

The Examining Attorney is tasked with evaluating the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the Examining Attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10<sup>th</sup> Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are confusingly similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10<sup>th</sup> Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though



both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods with which the marks are used, the nature and scope of a party’s goods must be determined on the basis of the goods recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston ComputergoodsInc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). *See generally* TMEP § 1207.01(a)(iii).

Even if the marks are similar, confusion is not likely to occur if the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create an incorrect assumption that they originate from the same source. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Purchasers who are sophisticated or knowledgeable in a particular field are not necessarily immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely as between Applicant's trademark and the trademark cited and, accordingly, the refusal to register ZENEK should be withdrawn.

### ***The Trademarks Are Similar***

At the onset, Applicant must concede that the cited trademark, ZENEC, and that of the Applicant, namely ZENEK, are similar as they relate to the analysis under the first *du Pont* factor. Although they are technically spelled differently, given the doctrine of phonetic equivalents it would strain credibility before this forum to set forth an argument that the marks are not similar.

However, notwithstanding this concession as to the first *du Pont* factor, Applicant nevertheless submits that the remaining factors establish that even despite the similarity in appearance as between the trademarks at issue confusion is not likely for the reasons more fully set forth below and, most particularly, the distinctions between the goods over which Applicant and the Examining Attorney disagree as to the reading of the identification set forth in the cited registration.

### ***Distinctions as Between Applicant's and Registrant's Goods***

The nature and scope the goods or services offered in connection with the Applicant's and the registrant's trademarks must be determined on the basis of the goods or services

identified in the application or registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 sF.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010). In this regard, critical to the instant refusal is the Examining Attorney's reading of the goods set forth in the registered mark's identification which differs from the Applicant's view of the same.

As the Board is aware, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine

selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

In the instant matter, the registered marks goods are identified as follows:

Apparatus for recording, transmitting and reproducing sound or images; radios, amplifiers, equalizers, loudspeakers, television apparatus, touchscreen monitors, liquid crystal display monitors, video monitors, video cameras, CD and DVD playing apparatus, all the aforesaid apparatus are also intended for mounting on vehicles; parts for all the above products.

U.S. Reg. No. 4503699.

Applicant sets forth that the phrase "...are also intended for mounting on vehicles" is a phrase limiting the goods of the registered mark to those preceding goods for use exclusively in mounting on vehicles. And herein lies the primary difference between Applicant's opinion and that of the Examining Attorney. The Examining Attorney, however, sets forth that the manner in which this is phrased is not limiting but rather inclusive. As more fully set forth in the final office action by the Examining Attorney on June 9, 2015:

Applicant's primary argument centers on the presumption that this is meant as a limitation of the identification. However, all doubt must be resolved in favor of the registrant in an ex parte proceeding. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003

(Fed. Cir. 2002). As such, the more appropriate reading of the identification is to read this language not as limiting, but as calling out a specific example of what the identification includes without excluding all other goods falling under the previously identifies categories of goods. For example, the identification is appropriately read to include all Apparatus for recording, transmitting and reproducing sound or images, radios, amplifiers, equalizers, loudspeakers, television apparatus, touchscreen monitors, liquid crystal display monitors, video monitors, video cameras, CD and DVD playing apparatus, including wearable technology identical to that identified in the application.

Office Action dated June 9, 2015. While Applicant agrees that all doubt must be resolved in favor of the registrant, such presumption should and does not extend to changing the plain wording of a limiting statement in an identification of goods to broaden the scope thereof.

Returning to the wording found in the cited registration, the primary semantical distinction focuses on the interpretation of the term “also”. The Examining Attorney reads this to mean the goods so identified “may also” be used in this fashion whereas the Applicant reads this language to read that they are “limited to” goods used in this fashion. It is suggested, however, the plain interpretation of the wording found in the identification favor’s Applicant’s analysis.

Specifically, examining the entire phrase, “...all the aforesaid apparatus are also intended for mounting on vehicles...” the wording clearly indicates that all of the products listed in the identification are “also” for mounting in vehicles. In that regard, the term “also” is intended to be a modifier for all of the products limiting the same to goods “for mounting in vehicles” and not, as the Examining Attorney contends, that can also, but are not limited to, mounting on vehicles.

In that regard, and with the clarification of the actual meaning of the identification of goods of the registrant hopefully established, Applicant submits that the goods as identified in its

application are sufficiently distinct from those identified in the cited registration to avoid a likelihood of confusion.

Applicant provides the following identification in the subject application:

Cell phones; computers; pc tablets; wearable digital electronic devices comprised primarily of software and display screens for the use of smart phone capabilities and also featuring a wristwatch; wireless indoor and outdoor speakers; all of the foregoing not for mounting on vehicles.

To the contrary, as interpreted, the registered trademark provides the following:

[A]pparatus for recording, transmitting and reproducing sound or images; radios, amplifiers, equalizers, loudspeakers, television apparatus, touchscreen monitors, liquid crystal display monitors, video monitors, video cameras, cd and dvd playing apparatus, all the aforesaid apparatus are [also] intended for mounting on vehicles; parts for all the above products.

Within this context, these differ insofar as the vast majority of the goods of the registrant do not overlap whatsoever with the goods of the Applicant. To the extent there is any perceived overlap, it would necessarily be “liquid display monitors” or “loudspeakers” for the registrant with the Applicant’s “display screens” or “indoor and outdoor speakers.” Upon closer inspection, however, there is no overlap here either.

One must recall, the “liquid display monitors” of the registrant are “intended for mounting on vehicles”. In other words, in regard to these monitors registrant’s goods are in-vehicle monitors akin to a modern radio face or perhaps TVs that are installed in the head rests or ceilings of cars. To the contrary, as also emphasized by Applicant’s recent amendment, Applicant’s “display screens” are for wrist watches or smart phones and are specifically exclude mounting in vehicles. As such, even for these alleged closest of goods there is simply no overlap in the same.

Likewise, even if we look at the registrant's "loudspeakers" such are relegated to "loudspeakers" mounted in vehicles. Traditionally, a loudspeaker is something one would make announcements on at an educational facility or the like. Having a loudspeaker mounted on a vehicle to some degree thus engenders a connotation of the speaker mounted on Jake and Elwood Blues car in the movie *The Blues Brothers*. But assuming loudspeaker means speaker, registrant's goods are still relegated to those mounted in cars whereas Applicant's are relegated to those not mounted in cars and, specifically, wireless indoor and outdoor speakers. As such, it is submitted that even when examining these goods, and assuming registrant meant speakers and not loudspeakers ala *The Blues Brothers*, the distinction between in-vehicle and indoor / outdoor speakers is sufficient to insure there is simply no overlap as between the goods of the Applicant and the registrant.

As such, and in consideration of these distinctions, it is respectfully submitted that the instant *du Pont* factor favors registration of the applied-for trademark.

#### ***Absence of Actual Confusion***

Finally, there is no evidence of record indicating that there has been actual confusion in the marketplace as between Applicant's goods and the registrant's goods.

The absence of any instances of actual confusion is a meaningful factor where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or all affected trademark owners. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

As the Examining Attorney has alleged, the Office believes that the Applicant's goods and those of the registered trademark travel in similar trade channels and are marketed in a similar enough manner to create a likelihood of confusion. While not conceding this point, provided that this is, in fact, the Office's position it would be contradictory to discount the absence of actual confusion as between the trademarks at issue where the Office contends there is an overlap in marketing and trade channels.

Accordingly, consistency in the Office's position, whether or not countered by the Applicant in the instant Argument, suggests that the Office should consider the absence of evidence of actual confusion to be a meaningful factor in the instant analysis, a factor which clearly supports registration of Applicant's Trademark under this *du Pont* factor.

### **CONCLUSION**

Based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's Trademark.

WHEREFORE it is respectfully requested that the Trademark Trial and Appeal Board reverse the decision of the Examining Attorney, remove as an impediment the cited trademark, and approve the instant Application for publication.

Respectfully submitted this 21<sup>st</sup> day of December, 2015,

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